

Serial No. 10/804,285

Page 11

REMARKS

Claims 1, 3-12, 15-25, 27-31, and 33-41 are pending in this application. By this Amendment, claims 1, 5, 21, 22, 31, 35, and 38 are amended and claims 2, 13, 14, 26, and 32 are cancelled without prejudice or disclaimer. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

The Office Action rejects, under 35 U.S.C. § 102, claims 1, 3-12, 14-16, 18-21, 23-31, 33-38, and 40-41 over Haarsten (U.S. Patent No. 6,112,088). The Office Action also rejects, under 35 U.S.C. § 103, claim 17 over Haarsten and Haddad (U.S. Patent Pub. No. 2003/0117978) and claims 2, 13, and 32 over Haarsten and Kallio (U.S. Patent Pub. No. 2002/0147008). The Office Action comments on claims 22, 39, and 41, but does not explicitly reject them based on a statutory basis or cited reference and only "notes" the rejection of claims 2, 13, 32, and 41. These rejections are respectfully traversed.

Applicants assert that Haarsten and Kallio do not disclose or suggest sending a transfer request to a second radio access network requesting transfer of an ongoing communication from a first radio access network to the second radio access network, wherein the first radio access network is a cellular radio access network and wherein the second radio access network is a wireless local area network, as recited in independent claim 1.

Applicants also assert that Haarsten and Kallio do not disclose or suggest sending a transfer request from a second radio access network to a first radio access network requesting transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the second radio access network comprises a wireless local area network and the first radio access network comprises a cellular radio access network, as recited in independent claim 5.

Applicants additionally assert that Haarsten and Kallio do not disclose or suggest receiving a transfer request from a second radio access network to a first radio access network requesting initiating a transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the second radio access network comprises a wireless local area network and the first radio access network comprises a cellular radio access network, as recited in independent claim 21.

Serial No. 10/804,285

Page 12

Applicants further assert that Haarsten and Kallio do not disclose or suggest a transfer request module coupled to a controller, the transfer request module configured to send a transfer request to a second radio access network requesting transfer of an ongoing communication from a first radio access network to the second radio access network, wherein the first radio access network is a cellular radio access network and wherein the second radio access network is a wireless local area network, as recited in independent claim 31.

Applicants also assert that Haarsten and Kallio do not disclose or suggest a transfer request communication module configured to send a transfer request from a second radio access network to a first radio access network requesting initiation of a transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the first radio access network comprises a cellular network and the second radio access network comprises a wireless local area network, as recited in independent claim 35.

Applicants additionally assert that Haarsten and Kallio do not disclose or suggest a transfer request module configured to receive a transfer request from a second radio access network to a first radio access network requesting initiation of a transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the first radio access network comprises a cellular network and the second radio access network comprises a wireless local area network, as recited in independent claim 38.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

Applicants assert the cited references do not provide a suggestion or motivation to combine the reference teachings and such is not provided by the Office Action. In particular, the Office Action only alleges "The motivation for using Kallio's teaching can be found in Kallio."

Serial No. 10/804,285

Page 13

However, Applicant cannot find any teaching in Kallio for combining its teachings with the specific radio communication system and method for mobile assisted handover between a private network and a public mobile network taught in Haarsten.

In fact, Applicants assert Kallio teaches away from the claimed invention. In particular, Kallio expressly teaches that during an active handover, when the mobile station initiates a handover from the GSM network to the wireless LAN, the mobile station sends a measurement report to a base station where the handover algorithm generates a handover request to the mobile switching center of the GSM network (paragraphs 0012, 0043, 0044, 0047, and 0049). In this case, the GSM network is allegedly the first radio access network that is a cellular network and the wireless LAN is the second radio access network. However, contrary to the claimed invention, a handover algorithm at the base station of the first radio access network generates the handover request. This is the opposite of the claimed sending a transfer request from the second radio access network to the first radio access network because the transfer request in Kallio is generated by the first radio access network.

To simplify, the claimed invention sends a transfer request from the second radio access network to the first radio access network. To the contrary, Kallio teaches the first radio access network generates the handover request. Thus, Kallio cannot send the handover request from the second radio access network to the first radio access network because it is already generated at the first radio access network. Consequently, Kallio teaches the opposite of the second radio access network sending a transfer request to the first radio access network. Therefore, Kallio teaches away from the claimed invention.

For the same reasons that Kallio teaches away from the claimed invention, neither reference discloses the claimed invention. In particular, Haarsten does not disclose the first radio access network being a cellular radio access network and the second radio access network being a wireless local area network and such is admitted by the Office Action. Furthermore, Kallio does not make up for the deficiencies of Haarsten. In particular, Kallio does not disclose sending a transfer request from a wireless local area radio access network to a cellular radio access network. As discussed above, Kallio actually teaches the opposite of the claimed invention.

Serial No. 10/804,285

Page 14

Applicants recognize that one reading the claimed invention may begin to recognize numerous benefits that suddenly become apparent only after reading the claimed invention. The more the exact words of the claims are read, the more one can realize the benefits only became apparent after reading Applicants' teachings. Upon reaching this realization, it is easy to notice that there is absolutely no evidence of motivation in the prior art and such evidence has not been provided by the Office Action. Furthermore, the Office Action has not alleged motivation is based on the nature of the problem to be solved or based on the knowledge of persons of ordinary skill in the art. Yet, such motivation is required for a proper rejection under 35 USC § 103 (*see* MPEP § 2143.01). Thus, once one notices there is no evidence of motivation in the prior art, one can understand that the Office Action has applied impermissible hindsight in attempting to combine the references.

Thus, Haarsten and Kallio do not disclose or suggest sending a transfer request to a second radio access network requesting transfer of an ongoing communication from a first radio access network to the second radio access network, wherein the first radio access network is a cellular radio access network and wherein the second radio access network is a wireless local area network, as recited in independent claim 1.

Also, Haarsten and Kallio do not disclose or suggest sending a transfer request from a second radio access network to a first radio access network requesting transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the second radio access network comprises a wireless local area network and the first radio access network comprises a cellular radio access network, as recited in independent claim 5.

Additionally, Haarsten and Kallio do not disclose or suggest receiving a transfer request from a second radio access network to a first radio access network requesting transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the second radio access network comprises a wireless local area network and the first radio access network comprises a cellular radio access network, as recited in independent claim 21.

Furthermore, Haarsten and Kallio do not disclose or suggest a transfer request module coupled to a controller, the transfer request module configured to send a transfer request to a

Serial No. 10/804,285

Page 15

second radio access network requesting transfer of an ongoing communication from a first radio access network to the second radio access network, wherein the first radio access network is a cellular radio access network and wherein the second radio access network is a wireless local area network, as recited in independent claim 31.

Also, Haarsten and Kallio do not disclose or suggest a transfer request communication module configured to send a transfer request from a second radio access network to a first radio access network requesting initiation of a transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the first radio access network comprises a cellular network and the second radio access network comprises a wireless local area network, as recited in independent claim 35.

Additionally, Haarsten and Kallio do not disclose or suggest a transfer request module configured to receive a transfer request from a second radio access network to a first radio access network requesting initiation of a transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the first radio access network comprises a cellular network and the second radio access network comprises a wireless local area network, as recited in independent claim 38.

Therefore, Applicants respectfully submit that independent claims 1, 5, 21, 31, 35, and 38 define patentable subject matter. The remaining claims depend from the independent claims and therefore also define patentable subject matter. Accordingly, Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of the pending claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Serial No. 10/804,285
Page 16

The Commissioner is hereby authorized to deduct any fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,



Matthew C. Loppnow
Attorney for Applicant
Registration No. 45,314

Dated: August 5, 2006

Phone No. (847) 523-2585
Fax No. (847) 523-2350

Please send correspondence to:
Motorola, Inc.
Intellectual Property
600 North U.S. Highway 45
Libertyville, IL 60048